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TELEPHONE: (801) 364-5633
FACSIMILE: (801) 355-8938
E-MAIL: foster@fosterpatlaw.com

LYNN G. FOSTER

REG. PROF. ENGINEER
ATTORNEY AT LAW
PATENT ATTORNEY

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DATE: June 22, 2006

TO: JACQUELINE STONE, DIRECTOR
TECHNOLOGY CENTER 1700

FAX NUMBER: (571) 273-8300

RE: Serial No. 09/930,539
Docket: 7310.C

TOTAL NUMBER OF PAGES INCLUDING COVER SHEET: 78

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**RECEIVED
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In re Patent Application of:			
	RODNEY M. LAFOLLETTE	Docket:	7310.C
Serial No.:	09/930,539	Art Unit:	1745
Filed:	August 14, 2001	Director:	Patrick Ryan
For:	MICROSCOPIC BATTERIES FOR MEMS SYSTEMS	Examiner:	RAYMOND ALEJANDRO

**RENEWAL OF PETITION UNDER
37 C.F.R. § 1.181(a)**

MAIL STOP - PETITIONS
JACQUELINE STONE, DIRECTOR
TECHNOLOGY CENTER 1700
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. PRIOR PETITION WAS GRANTED

Applicants' Response to Notification of Non-Compliant Appeal Brief was treated as a rule 1.181(a) Petition and the Petition was granted. A copy of the Decision on Petition is attached as Exhibit "H."

Director Jacqueline Stone, on November 17, 2005, in the favorable Decision on Petition, among other things, found:

In view of the current application being a continuation, the claims have been rejected more than two times and are proper for appeal.

The application is being forwarded to the Examiner for consideration of applicants amendment received November 15, 2004 and if the amendment is in compliance to then consider applicants appeal brief and to file an Examiner's answer in response to applicant's appeal brief.

II. THE HISTORY OF DELAYS

In the seven (7) months since the date of the Decision, the delays by the Examiner have persisted and the Examiner is entirely non-compliant with the mandates of the Decision on Petition, greatly to the prejudice of the Applicants.

Add this delay to the cumulative delays of the past and it is clear the Applicants have sought a meritorious adjudication for over eight years of a profoundly inventive integratable microfabricated battery for MEMS (microelectromechanical systems) set forth in the present claims and the elected claims of parent Application No. 09/037,801 filed March 10, 1998.

The Brief on Appeal in this Application was filed about nineteen months ago and the Examiner, setting his own rules and defying the Decision on Petition refuses to file his Answer.

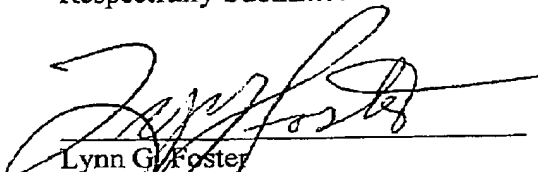
III. THE RELIEF SOUGHT

For the reasons more fully set forth in the attached Brief in Support of Renewal of Petition, the Applicants request the following:

1. This Application be reassigned to another, successor Examiner to insure prompt filing of the Examiner's Answer.
2. Jacqueline Stone supervise an expedited preparation of the Examiner's Answer.
3. The Examiner be instructed to file with the Board of Patent Appeals and Interferences and serve on the Attorney for the Applicants the Examiner's Answer within fifteen (15) days of the decision on this Renewal Petition.

Please charge all fees, if any, to deposit account 06-1620 of the undersigned.

Respectfully Submitted



Lynn G. Foster
Attorney for Applicants

JUN 22 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	
RODNEY M. LAFOLLETTE	Docket: 7310.C
Serial No.: 09/930,539	Art Unit: 1745
Filed: August 14, 2001	Director: Patrick Ryan
For: MICROSCOPIC BATTERIES FOR MEMS SYSTEMS	Examiner: RAYMOND ALEJANDRO

BRIEF IN SUPPORT OF RENEWAL OF PETITION UNDER
37 C.F.R. § 1.181(a)

MAIL STOP - PETITIONS
JACQUELINE STONE, DIRECTOR
TECHNOLOGY CENTER 1700
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. PRIOR PETITION WAS GRANTED

Applicants' Response to Notification of Non-Compliant Appeal Brief was treated as a Rule 1.181(a) Petition and was granted on November 17, 2005. A copy of the Decision on Petition is attached as Exhibit "H."

Since November 17, 2005 (over seven months), the Examiner has entirely failed to comply with the instructions of the Decision.

II. THE HISTORY OF DELAYS AND MISEXAMINATIONS

For over eight years, delays and misexaminations have been heaped upon the impecunious Applicants. There can be no bona fide justification. The same Examiner recognized the breadth of the present invention when he issued continuing Application

No. 09/627,959 as U.S. Pat. No. 6,610,440 granted August 26, 2003, the claim of which reads:

1. A microfabricated battery comprising a pair of microscopic electrodes, a microscopic amount of electrolyte disposed in a microscopic site between the electrodes, the microfabricated battery comprising an area as small as one square micron.

The long and painful prosecution history of this continuation Application and parent Application No. 09/037,801 are, among other things, set forth in some detail below.

III. ORIGINAL AND CONTINUING U.S. PATENT APPLICATIONS

A. The Invention

For years, tiny MEMS (microelectromechanical systems) and other tiny microcircuits of similar size have been powered by relatively large non-integrated external sources of electrical power. With the sole exception of the present invention, MEMS continue to be powered by such large non-integrated external sources of electrical power. The present invention uses microfabrication to create a battery so small it is nearly invisible to the human eye to provide an integratable and rechargeable battery for MEMS.

B. The First Application

The parent Application is No. 09/037,801 filed March 10, 1998 (Docket 7310) and contained 102 Claims.

1. The Restriction in Parent

On September 9, 1999, the present Examiner issued an ill-founded twenty three (23) way restriction and species election requirement. See attached Exhibit "A." This was reduced, on February 16, 2006, to a five (5) way restriction with no species

requirement, pursuant to a Petition to Vacate Restriction and Species Requirement, which lead to an interview **Agreement** involving Applicants' attorney, the Examiner, and the Examiner's supervisor, Marie Nuzzolilio. *See attached Exhibit "B."* This restriction agreement was not limited this first parent application. Note, the Applicants' election of Claims 10-43, 51-54, 89-92 and 97 in the parent application responsive to the five (5) way restriction. Repeatedly, in continuing application, the same Examiner has refused to honor the Restriction Agreement.

2. The First Rejection in Parent

The Examiner rejected all of the elected Claims under 35 U.S.C. § 103(a) on Hockaday (5,759,712) in view of Hockaday (5,631,099). Supervisor Nuzzolilio disqualified Hockaday '712 because it is concerned with fuel cells. *See attached Exhibit "C."*

3. Amendments and Declarations Responsive to the First Rejection in Parent

By Amendment mailed March 7, 2000, the elected claims were amended. By supplement Amendment faxed May 5, 2000, Claims 94 and 95 were nominally amended.

Rodney LaFollette, a renown battery expert and co-inventor, mailed a Declaration on March 7, 2000 and a Supplement Declaration on April 17, 2000, demonstrating the patentability of the elected claims over the two Hockaday references.

4. The Second Rejection in Parent

The Examiner issued a second rejection of all elected claims (Claims 10-43, 51-54, 89-92 and 94-97) on May 17, 2000 under 35 U.S.C. § 103(a) on Arledge (5,437,941).

5. Amendment and Declaration Responsive to the Second Rejection in Parent

The Applicants mailed a further Amendment and a Second Declaration of Dr. LaFollette on August 15, 2000. New Elected Claims 103-109 were added.

6. The Third and Final Office Action in Parent

Giving no weight to Dr. LaFollette's powerful evidence showing Arledge (5,437,941) was inapplicable, the Examiner issued his final office action on October 20, 2000 rejecting all elected claims under 35 U.S.C. § 103(a) on Arledge.

Arledge was later entirely dropped as a reference in continuing applications directed to essentially the same claimed subject matter as the elected claims in this parent application.

7. After Final Amendment and Third Declaration of Dr. LaFollette and Request to Withdraw Final in Parent

On December 15, 2000, the Applicants filed an after final Amendment, a Third Declaration of Dr. LaFollette and a request that the Examiner withdraw the final. The Examiner denied the request, gave no weight to the Third Declaration and refused entry of the Amendment.

8. The CPA

The Applicants filed a Continued Prosecution Application (CPA) on January 11, 2001.

9. The Fourth Rejection in Parent

On February 20, 2001, the Examiner again rejected all elected claims on both Arledge alone and Shokoohi (5,110,696) under 35 U.S.C. § 103(a).

In continuation Application No. 09/930,539, the Examiner later dropped both of these references.

10. Continuation Application

In lieu of an appeal and in the hope that deserved and valuable patent rights would otherwise be more rapidly obtained, the impecunious Applicants filed a continuation application, i.e., Serial No.: 09/930,539. (Docket 7310.C).

IV. FIRST CONTINUATION APPLICATION (No. 09/930,539) on August 14, 2001.

A. The present Application was filed as a first continuation Application No. 09/930,539

1. Preliminary Amendment

Elected Claims 10-43, 51-54, 89-92, 94-97 and 103-109 of parent application No. 09/037,801 were placed in this continuation application.

2. Amendment Before First Action

An Amendment Before First Action was Mailed December 13, 2002, amending Claims 10-43, 51-54, 89-92, 94-96, 103, 105-109.

3. Petition to Make Special

Petition to make special was filed April 8, 2004 and was granted on May 18, 2004.

4. The Improper Restriction

In parent Application No. 09/037,801, Claims 10-43, 51-54, 89-92, 94-97 and 103-109 were conclusively found by agreement to embrace one invention. *See* attached Exhibit "B," the Restriction Agreement.

The Examiner arbitrarily repudiated the Exhibit "A" Restriction Agreement. Specifically, the Examiner issued in June 4, 2004 an improper restriction and species

requirement, copy attached as Exhibit "D," erroneously contending the single invention of the elected claims of parent Application No. 09/037,801, were now multiple inventions and multiple species. To the Applicants, this suggested an examination bias.

5. The Election

Left with no choice, the Applicants, on June 28, 2004, elected Claims 21-40 (20 Claims) instead of 53 Claims of the parent Application.

6. The First Office Action

Discarding all prior art earlier relied upon, i.e. the two Hockaday references, the Arledge reference and the Shookoohi reference, the Examiner rejected Claims 21-31, 33-36 and 38-40 under 35 U.S.C. § 102(b) on Bates (5,455,126). Claims 26-28, 32 and 37 were also rejected under 35 U.S.C. § 103(a) on Bates in view of Miekka (6,045,942).

This was the fifth rejection of claims directed to the same invention. Since, the art relied upon by the Examiner as to claims having the same inventive subject matter changed for the third time, a further indication of examination bias was apparent.

7. Response to the First Office Action in the First Continuation

Dr. LaFollette filed a comprehensive October 2004 Declaration in response to the First Office Action demonstrating patentability over Bates and Miekka and that the technologies of these two references were incompatible and not combinable.

A clarifying Amendment was also filed.

8. The Notice of Appeal

A notice of Appeal was mailed November 19, 2004. This vested jurisdiction in the Board of Patent Appeals and Interferences.

9. The Brief on Appeal and Appendix

On December 2, 2004, Applicants timely filed their Brief on Appeal and Appendix.

10. The Delay Following Filing of the Appeal Brief and Appendix

The long delay after the Appeal Brief and Appendix were filed have inured greatly to the prejudice of the Applicant, as demonstrated below.

11. The Amendment Received November 15, 2004

The non-compliant notice of November 12, 2004 and issues related thereto were resolved by an Amendment by the U.S. Patent Office on November 15, 2004.

12. The Erroneous Notification of Non-Compliant Appeal Brief

The Examiner erroneously issued on February 16, 2005 a Notification of Non-Compliant Appeal Brief. *See* Attached Exhibit "E."

The Examiner, ignoring the Amendment received November 15, 2004, acknowledged the "twice rejected" rule for an appeal and that the two rejections don't have to have been in a single application.

The Examiner, however, erroneously contended and continues to contend that the twice rejected claims must contain essentially identical limitations and, if the limitations are changed, the right to appeal the twice rejected claims is lost.

13. Response to Notification of Non-Compliant Appeal Brief

The Response to Notification of Non-Compliant Appeal Brief was sent by facsimile to the Examiner and the Group Director on March 11, 2005. *See* attached Exhibit "F." This response emphasized the controlling decisions of Ex Parte Lemione, 46 USPQ2d 1420 (Bd. 1998), holding the limitations in the claims do not control, but an appeal is available "so long as the applicant has twice been denied a patent."

Both the Examiner and the Group Director were non-responsive.

14. The July 11, 2005 Interview

To overcome the four months of silence by the Examiner and advance the case by obtaining an Examiner's Answer, an interview was held on July 11, 2005, a Summary of which is attached as Exhibit "G." While the Group Director indicated in the interview he would obtain assistance and report quickly to the undersigned, no report from either the Group Director or the Examiner ever occurred in the almost one year that has passed since the interview.

15. The Decision by the Technology Director on Petition

The Response to Notification of Non-Compliant Appeal Brief was treated as a Petition under Rule 37 C.F.R. § 1.18(a) and a Decision on the Petition was mailed November 17, 2005, a copy of which is attached as Exhibit "H." The Decision in essence held: (1) 'the Amendment' received November 15, 2004 appeared to be compliant and a suitable basis for appeal; (2) the Examiner was to: (a) confirm the compliance of said Amendment; (b) consider the Appeal Brief; and (c) file an Examiner's Answer; and (3) the jurisdiction of the Board was properly invoked. In pertinent part the decision states:

In view of the current application being a continuation, the claims have been rejected more than two times and are proper for appeal.

The Examiner, greatly to the prejudice of the Applicants, continues to refuse to file the Answer.

16. The April 17, 2006 Notification of Defective Appeal Brief

Since the date (November 17, 2005) of the Decision on Petition, the Examiner continues his prejudicial delays and silence. This stonewalling continues to make it impossible for the Applicants to gain a decision from the Board as to the patentable

merits of the appealed claims eight years after the parent application and about one and one-half years since the Appeal Brief was filed.

The latest delay defies the Technology Director's Decision on Petition in the form of a document mailed April 17, 2006, entitled on page 1 thereof as "Communication Re: Appeal" but characterized on page 2 as "Notification of Defective Appeal Brief," copy attached as Exhibit "I." This Exhibit "I" Notification, which is substantively identical to the Exhibit "E" Notification, is erroneous and completely defies the Decision on Petition. Greatly to the prejudice of the Applicants, the Examiner is and for an unacceptably long time has been non-compliant with MPEP § 1207.02, which states:

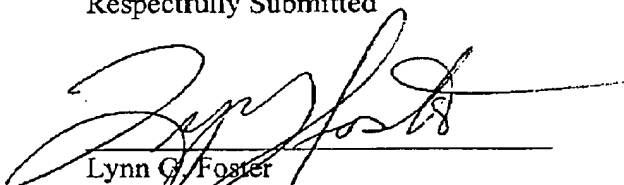
The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner.

V. CONCLUSION

The conduct of the Examiner has been prejudicial to the Applicants over an eight year interval of time, has been disobedient of the granting of the Petition to Make Special and entirely defies and ignores the Exhibit "H" Decision on Petition.

The relief requested in the accompanying Renewal Petition is proper and should be granted.

Respectfully Submitted



Lynn G. Foster
Attorney for Applicants

EXHIBIT “A”

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/037,801 03/10/98 LAFOLLETTE

R 7310

LYNN G FOSTER
FOSTER & FOSTER
602 EAST 300 SOUTH
SALT LAKE CITY UT 84102

IM22/0905

EXAMINER

ALEJANDRO, R

ART UNIT

PAPER NUMBER

1745

DATE MAILED:

09/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

RECEIVED
SEP 14 1999
Foster & Foster L.C.

Office Action SummaryApplication No.
09/037,801

Applicant(s)

Lafollete et al.

Examiner
Raymond AlejandroGroup Art Unit
1745

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-102 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-102 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Application/Control Number: 09/037801

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Art Unit: 1745

DETAILED ACTION

Election/Restriction

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1, drawn to a microelectro-mechanical system and a source of electrical energy, classified in class 429, subclass 122.
 - II. Claims 2, 75 and 77, drawn to a microelectro-mechanical system and a microscopic battery, classified in class 429, subclass 122.
 - III. Claim 3, drawn to a microelectronic circuit and a microscopic battery, classified in class 429, subclass 122.
 - IV. Claims 4-9, drawn to a microelectronic circuit and a microscopic battery, classified in class 429, subclass 122.
 - V. Claims 10-20 and 76, drawn to a microscopic circuit, a microelectro-mechanical system and an aqueous microscopic battery, classified in class 429, subclass 122.
 - VI. Claims 21-32, drawn to a microscopic rechargeable battery comprising etched spaced electrodes, classified in class 429, subclass 128.
 - VII. Claims 33-40, drawn to a microscopic rechargeable battery comprising separated microscopic electrodes, classified in class 429, subclass 209.
 - VIII. Claim 41, drawn to a method, classified in class 29, subclass 623.1.
 - IX. Claim 42, drawn to a method, classified in class 29, subclass 623.1.

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- X. Claim 43, drawn to a method, classified in class 29, subclass 623.1.
- XI. Claims 44-50, drawn to a method, classified in class 29, subclass 623.1.
- XII. Claims 51-54, drawn to a method of making a microscopic battery, classified in class 29, subclass 623.1.
- XIII. Claims 55-63, drawn to a method of making a microscopic battery, classified in class 29, subclass 623.1.
- XIV. Claim 64, drawn to a microscopic battery comprising a thin microscopic rod-shaped electrode, classified in class 429, subclass 128.
- XV. Claims 65-69, 82 and 93, drawn to a multicell rechargeable microscopic battery, classified in class 429, subclass 149.
- XVI. Claims 70-73, 81, 83-85 and 88-92 and 94, drawn to a microscopic conformal microscopic battery comprising an electrolyte, classified in class 429, subclass 126.
- XVII. Claim 74, drawn to a microelectro-mechanical system and a rechargeable microscopic battery, classified in class 429, subclass 122.
- XVIII. Claim 78-80, drawn to an integrated microelectronics system, classified in class 429, subclass 122.
- XIX. Claim 86, drawn to a microscopic battery comprising spaced concentric electrodes, classified in class 429, subclass 209.
- XX. Claim 87, drawn to a method of making a microscopic battery, classified in class 29, subclass 623.1.

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XXI. Claim 95-97, drawn to a method of making a microscopic battery, classified in class 29, subclass 623.1.

XXII. Claim 98-100, drawn to a method of confirming the size of a microscopic battery feature, classified in class 29, subclass 623.1.

XXIII. Claim 101-102, drawn to a method of unitarily fabricating an integrated circuit and microscopic battery, classified in class 29, subclass 623.1.

2. Inventions A (including the following groups VIII to XIII and XX to XXIII) and B (including the following groups I to VII and XIV to XIX) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case that the product as claimed can be made by another and materially different process for example the battery could be made along with the MEMS of the microcircuit.

Thus, applicant must elect one of the above groups or the applicant may elect one of the species below.

Application/Control Number: 09/037801

Page 5

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In addition, further restriction is necessary within inventions A and B:

3. This application contains claims directed to the following patentably distinct species of the claimed invention of: **Group B including the following species I, II, III, IV, V, VI, VII, XIV, XV, XVI, XVII, XVIII and XIX; or Group A including the following species VIII, IX, X, XI, XII, XIII, XX, XXI, XXII and XXIII.**

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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Page 6

Art Unit: 1745

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Alejandro whose telephone number is (703) 306-3326. The examiner can normally be reached on Monday- Friday from 8:00 am to 5:30 pm, with the second Friday of each biweek off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maria Nuzzolillo, can be reached at (703) 305-3776 on Monday-Friday, with the first Friday of each bi-week off.

In order to transmit an unofficial fax, the number is (703) 306-3429. In order to transmit an official fax/amendments after final, the number is (703) 305-3599.

Application/Control Number: 09/037801

Page 7

Art Unit: 1745

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Maria Nuzzolillo
Supervisory Patent Examiner
Technology Center 1700

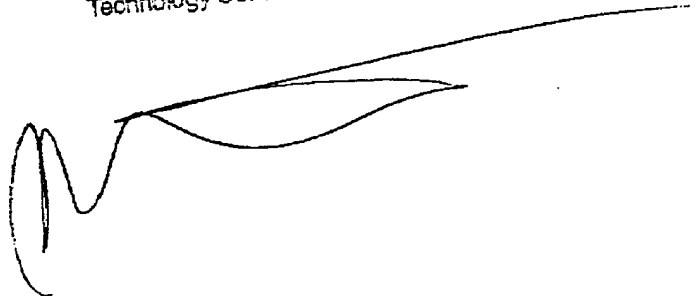


Exhibit “B”



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Mailed: FEB 16 2000

VI
Paper Number 11

In re application of:
Rodney M. LAFOLLETTE et al.
Serial No.: 09/037,801
Filed: March 10, 1998
For: MICROSCOPIC BATTERIES
FOR MEMS SYSTEMS

**DECISION ON
PETITION**

This is a decision on the petition filed on December 9, 1999 (Paper No. 10) to request withdrawal of a twenty three-way restriction requirement along with an additional election of species requirement (see Paper No. 7). Although applicants did not indicate the rule under which the petition was filed, it is noted that a petition from a restriction requirement is considered under 37 CFR 1.144.

DECISION

In light of the agreement reached between the examiner and applicants regarding a newly proposed five-way restriction requirement along with applicants' election of claims 10-43, 51-54, 89-92 and 94-97 (cf. the Interview Summary Record of February 3, 2000), the petition is rendered moot. The application is returned to the examiner with the directive to set forth the new restriction requirement followed by an examination on the merits of the above identified elected claims.

The petition is **DISMISSED**.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

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Foster & Foster L.C.

Lynn G. Foster
FOSTER & FOSTER
602 East 300 South
Salt Lake City, Utah 84102



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Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/087,801	03/10/99	LAFOLLETTE	R 7310

LYNN G FOSTER
FOSTER & FOSTER
602 EAST 300 SOUTH
SALT LAKE CITY UT 84102

IM62/0220

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ART UNIT	PAPER NUMBER
1745	18

DATE MAILED: 02/23/99

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FEB 23 2006

Foster & Foster L.C.

Office Action SummaryApplication No.
09/037,801

Applicant(s)

Lafollete et al.

Examiner
Raymond AlejandroGroup Art Unit
1745☒ Responsive to communication(s) filed on 12/16/99☐ This action is FINAL.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1835 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).


Disposition of Claim☒ Claim(s) 1-102 is/are pending in the applicationOf the above, claim(s) 1-9, 44-50, 55-88, 93, and 98-102 is/are withdrawn from consideration☐ Claim(s) _____ is/are allowed.☒ Claim(s) 10-43, 51-54, 89-92, and 94-97 is/are rejected.☐ Claim(s) _____ is/are objected to.☒ Claims 1-102 are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☒ The drawing(s) filed on 3/10/98 is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☒ The specification is objected to by the Examiner.☒ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☒ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____☒ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☒ Notice of informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

JUN 22 2006

Interview Summary	Application No. 09/037,801	Applicant(s) Lafollette	
	Examiner Maria Nuzzolillo	Group Art Unit 1745	

All participants (applicant, applicant's representative, PTO personnel):

(1) Maria Nuzzolillo (3) _____

(2) Mr. Lynn Foster (4) _____

Date of Interview Feb 3, 2000

Type: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☒ No. If yes, brief description:

Agreement ☒ was reached. ☐ was not reached.

Claim(s) discussed: Claims of proposed group, i.e. 10-43; 51-55; 78; 80-88; 94-105

Identification of prior art discussed:

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Agreement was reached to examine elected claims of newly proposed Group I. Thus, the examiner will examine on the merits claims 10-43; 51-54; 89-92 and 94-97.


(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. ☐ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. ☐ Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

Supervisory Patent Examiner
Technology Center 1700



Examiner Note: You must sign and stamp this form unless it is an attachment to a signed Office action.

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Art Unit: 1745

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, 75-77 and 79, drawn to a source of electrical energy having a MEMS, classified in class 429, subclass 7.
 - II. Claims 10-43, 51-54, 89-92 and 94-97, drawn to a microscopic battery integrated with a microelectronic circuit, classified in class 429, subclass 122.
 - III. Claims 44-50, 56-69 and 93, drawn to a method for fabricating a microscopic battery, classified in class 29, subclass 623.1.
 - IV. Claims 55, 78, 80-88 and 98-105, drawn to a method of making a microscopic battery forming several microscopic cells, classified in class 29, subclass 623.1.
 - V. Claims 70-74 and 89-92, drawn to a microscopic conformal microscopic battery, classified in class 429, subclass 126.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects.
3. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be

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Art Unit: 1745

used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different product.

4. Inventions IV and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process.

5. Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects.

6. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process.

7. Inventions IV and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be

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made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process.

8. Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects.

9. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects.

10. Inventions III and V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process.

11. Inventions IV and V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process.

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12. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

13. Because these inventions are distinct for the reasons given above and the search required for one group is not required for the other group, restriction for examination purposes as indicated is proper.

14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

15. During a conversation between Mr. Vasu and Ms. Maria Nuzzolillo and the Applicant's Attorney 02/03/00 a provisional election was made with traverse to prosecute the invention of Group II, claims 10-43, 51-54, 89-92 and 94-97. Affirmation of this election must be made by applicant in replying to this Office-action. Claims 1-9, 44-50, 55-88, 93 and 98-102 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Exhibit “C”



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARK
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/037801

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

INTERVIEW SUMMARY

All participants (applicant, applicant's representative, PTO personnel):

(1) Raymond Alejandro (3) Lynn G. Foster
(2) Maria Nuzzolillo (4) _____

Date of Interview: _____

Type: ☐ Telephonic ☐ Televideo Conference ☒ Personal (copy is given to ☐ applicant ☒ applicant's representative).Exhibit shown or demonstration conducted: ☐ Yes ☐ No If yes, brief description: _____Agreement ☐ was reached. ☒ was not reached.Claim(s) discussed: allIdentification of prior art discussed: Hochaday 5759712 & Hochaday 5631099

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Agreement was reached that the reference 1712 does not render the
claims obvious as it is directed to a fuel cell (miniature).
We will also review the amendment and
specification for any issues concerning "microscopic".

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

☒ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

Examiner Note: You must sign this form unless it is an attachment to another form.

Ray Alejandro
05/03/00

MARIA NUZZOLILLO
SPF 1745
5/3/00

FORM PTOL-413 (REV. 2-98)

Exhibit “D”



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,539	08/14/2001	Rodney M. LaFollette	7310.C	7186

7590

06/04/2004

Foster & Foster, LLC
Mr. Lynn G. Foster
600 E. 300 S.
Salt Lake City, UT 84102

EXAMINER

ALEJANDRO, RAYMOND

ART UNIT

PAPER NUMBER

1745

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/930,539

Applicant(s)

LAFOLLETTE ET AL.

Examiner

Raymond Alejandro

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 153). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/14/01, 12/19/02 & 05/18/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-43, 51-54, 89-92, 94-97 and 103-109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 10-43, 51-54, 89-92, 94-97 and 103-109 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Art Unit: 1745

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DETAILED ACTION

Election/Restrictions

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 10-40, 89-92, 94, 103-107 and 109, drawn to microfabricated batteries, classified in class 429, subclass 122.
 - II. Claims 41-43, 51-54, 95-97 and 108, drawn to methods comprising the acts of fabricating or methods of making microfabricated batteries, classified in class 29, subclass 623.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process, (*as admitted by the applicants*) the battery can be made by etching, metallic deposition, layer lithographic patterning and the like.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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Art Unit: 1745

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In addition, further restriction is required. Thus, applicant must elect one (1) of the above groups and one (1) of the species below.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: the battery or method including microelectronic circuit/microcircuitry per se;

Species 2: the battery or method including microelectromechanical system per se;

Species 3: the battery or method having no microelectronic circuit/microcircuit or microelectromechanical system (not including microelectronic circuit/microcircuitry or microelectromechanical system);

Species 4: the battery or method including the microscopic wire and hollow tubular electrode;

Species 5: the battery or method comprising the specific power output,

****Examiner's note: it is also noted that the present claims also contain what appears to be several additional species of mutually exclusive battery embodiments or characteristics, for example:*

a) rechargeable or primary battery;

b) electrode comprising a conductive film or rigid dielectric substrate or flexible sheet or etched profile;

c) battery geometry selected from the group consisting of a flat cell, spirally wound; bipolar or linear;

d) battery geometry selected from the group consisting of wire-shaped, odd-shaped, wire in a can, or peg in a block;

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thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Exhibit “E”



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,539	08/14/2001	Rodney M. LaFollete	7310.C	7186

75841

02/16/2005

Foster & Foster, LLC
Mr. Lynn G. Foster
600 E. 300 S.
Salt Lake City, UT 84102

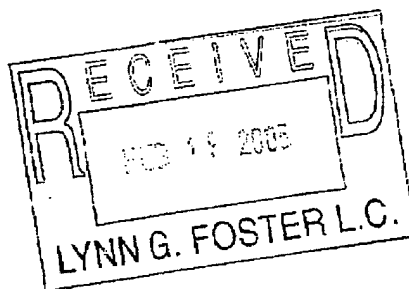
EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



JUN 22 2006

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 09/930,539	Applicant(s) LAFOLLETTE ET AL.	
	Examiner Raymond Alejandro	Art Unit 1745	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 06 December 2004 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file a complete new brief in compliance with 37 CFR 41.37 within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

see next page.

Raymond Alejandro
Examiner
Art Unit: 1745

Application/Control Number: 09/930,539
Art Unit: 1745

Page 2

DETAILED ACTION

This Notification of Non-Complaint Appeal Brief is being provided in response to the Appeal Brief filed on 12/06/04.

In this regard, it is noted that under 37 CFR 1.191(a), an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal and the required fee set forth in 37 CFR 1.17(b) within the time period provided under 37 CFR 1.134 and 1.136. A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of "twice or finally...rejected" does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application (*See MPEP 1205 Notice of Appeal*).

In this instance, the present appeal brief fails to meet the requirement of having the claims twice rejected simply because the appealed claims and their intended subject matter have never been rejected by the examiner. That is to say, the intended amendment of 10/14/04, the substitute amendment of 11/01/04, and the supplemental amendment of 11/09/04 incorporating new limitations into the claims (*i.e. the specific foot print area as low as 0.001 cm² in claim 21; and the specific footprint within a range of less than 1 cm² to 0.0001 cm² and the connotation of the micro-fabricated limitation in claim 33*) were never made of record and officially entered due to its non-compliant condition as set forth in various Notices of Non-Compliant Amendment

Application/Control Number: 09/930,539
Art Unit: 1745

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dated 10/22/04 and 11/15/04 identifying the lack of a complete listing of all of the claims, and/or in the Failure to Acceptably Respond to Notice of Non-Compliant Amendment of 11/23/04. The foregoing non-compliant communications were issued by the Technical Support Team of PTO, and they do not reflect, in any way, an official examination on the merits of claims. Thus, since the appealed claims include non-entered amendments and unexamined subject matter, it is contended that the appealed claims have not been considered and examined on their merits. Additionally, the appeal is not in compliance with 37 CFR 41.31(a)(1) in that no claim has been twice rejected.

In consequence, the appeal brief is defective as it unfairly appeals subject matter never entered and made of record by PTO; and ultimately, never considered and examined on the merits by the examiner. To remedy this defectiveness, applicant is suggested to either: a) cancel or delete the intended new limitations (the limitations newly added in the amendment not-entered) so as to fairly appeal the examiner's rejection based on the original claimed subject matter of the current application; or b) withdraw the appeal brief and allow the application continues its regular course of action and examination. If applicant desires to adopt any of aforementioned suggestions or any other action, applicant is still reminded of his obligation to submit a proper reply addressing this issue so as to avoid an abandonment due to applicant's failure to offer a proper reply timely filed.



Exhibit “F”

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	
RODNEY M. LAFOLLETTE, ET AL.	Docket: 7310.C
Serial No.: 09/930,539	Art Unit: 1745
Filed: August 14, 2001	Examiner: Raymond Alejandro
For: MICROSCOPIC BATTERIES FOR MEMS SYSTEMS	

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Patrick Ryan
Director - Group 1740
Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

Sir:

This is in response to the erroneous Notification of Non-Compliant Appeal Brief (Notification), copy appended as Attachment C and invokes the authority of the Director of Patent Examining Group 1740.

The Notification, while citing to 37 CFR § 1.191(a) and MPEP 1205, draws clearly erroneous conclusions, i.e.:

1. The appealed claims having identical substance must be twice rejected and, therefore, if a claim is amended after a second rejection, an appeal as to that claim is not timely.
2. That certain claims have not been entered prior to the Notice of Appeal when they have or should have been entered.
3. The Appeal Brief unfairly appeals subject matter never examined.
4. That the Applicant must cancel limitation or language added by amendment and thereby return the appealed claims to their state prior to the amendment or withdraw the appeal.

The Group 1740 Director is respectfully requested to correct the errors of the Examiner, pointed out above, and to take certain additional action identified below.

First, the Director is requested to cause any non-entered amendments to be entered. Second, if there are further procedural requirements for such entry, the undersigned should be immediately notified.

Third, the Director is requested to bring this case of Ex parte Lemoine, 46 USPQ 2d 1420 (Bd of Pat App and Interf. 1998) to the attention of the Examiner. A copy of this case is attached as Attachment B. Lemoine unequivocally rejects the erroneous appealability positions of the Examiner, holding that it is not the exact limitations of appealed claims nor whether the claims have been rejected in the case placed on appeal that determine appealability.

The Board in Lemoine, at 1422-1423, specifically held:

Section 134 of Title 35 gives applicants the statutory right to an administrative appeal. The section provides:

An applicant for a patent, any of whose claims have been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences

Jurisdiction for this appeal depends on whether appellant is an applicant "any of whose claims has been twice rejected." We conclude that appellant had the right to appeal the rejections and we have jurisdiction.

To reach a decision requires us to construe the word "claims" as used in § 34 [sic, §134]. The word is susceptible to at least two interpretations. It can refer to the claims of an application, *i.e.*, the "one or more claims particularly pointing out and distinctly claiming the subject matter" of the invention required by 35 U.S. C. § 112, ¶ 2. Or the word can be used in a more general sense to refer to claims "for a patent" as it is used in 35 U.S.C. § 132. In this latter sense, the word is synonymous with a request or demand for a patent.

* * * *

. . . we conclude that the "claims" as used in § 134 is a

reference to the repeated "claim for a patent" as used in § 132.